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Supreme Court of the United States.

OCTOBER TERM, 1949.

No. 231.

STANDARD DUPLICATING MACHINES COMPANY, INC.,
Petitioner,

v.

AMERICAN BUSINESS MACHINES CORPORATION,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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The petitioner seeks by its petition to upset the decision of the United States District Court, reported 77 Fed. Supp. 871, and the affirming decision of the Court of Appeals for the First Circuit, reported 81 U.S.P.Q. 239; rehearing denied May 19, 1949.

This is a patent case concerning the application of the Disclaimer Statutes, R.S. secs. 4917 and 4922, 35 U.S.C. secs. 65 and 71. Both sections relate to the predicament of a patentee who discovers that he has inadvertently claimed in his patent more than he had invented. Ordinarily the fact appears when a court holds one or more of the patent claims to be invalid, as happened in the case at bar.

The deep-rooted abhorrence of the public for illegal monopolies was responsible for the common-law doctrine that, if any claim was held invalid, the entire patent fell.

Ensten v. *Simon, Ascher & Co., Inc.*, 282 U.S. 445. The holding of invalidity of one claim was in fact an adjudication that the patentee had been asserting an illegal monopoly in derogation of the interests of the public. The British Statute of Monopolies of 1623 (Walker on Patents, 1937 Edition, vol. 1, p. 18) carefully distinguished between illegal monopolies (prescribing penalties against those found guilty of asserting them) and the monopoly which might lawfully be granted to the inventor or discoverer of something which was not before known. Consequently the loss of the entire patent was regarded as a penalty properly imposed against one who had asserted an illegal monopoly by claiming in his patent more than that which he had invented.

We strike this note at the outset because the petitioner's case entirely disregards considerations of public policy and completely overlooks the philosophy underlying the disclaimer statutes. Congress passed the disclaimer statutes because it was felt that the loss of the entire patent was perhaps in certain cases an unnecessarily harsh penalty. Consequently it was provided that, where the assertion of the illegal monopoly was due to innocent inadvertence, accident or mistake, the patentee should be given the privilege of salvaging by disclaimer so much of his patent as truly defined an invention.

There are two conditions imposed upon a disclaiming patentee. The first condition is that the disclaimer be filed promptly, a requirement obviously imposing upon the patentee the duty to excise the invalid claims without delay in order to end the assertion of an illegal monopoly. The second requirement is that the patentee disclaim everything not "definitely distinguishable from the parts claimed without right." In view of the historical background of this subject, it is our contention that, where there is a doubt as to whether one claim is definitely distinguish-

able from another, that doubt should be resolved *in favor of the public.* The petitioner, on the other hand, attempts to induce the Court to believe that in case of doubt the matter should be resolved in favor of the patentee. Such an interpretation would obviously conflict squarely with the *raison d'être* of the disclaimer privilege.

Outline of the Case.

Coming now to a consideration of the facts to which the preceding general remarks may be applied, we find that the Storck patent in suit was in issue in *Standard Mailing Machine Company* v. *Ditto, Inc.,* 100 F. (2d) 466. The outcome of that suit was an adjudication that certain claims were valid but that claim 8 was invalid. Within a reasonably prompt time after the issuance of the decision petitioner disclaimed claim 8. The Court of Appeals for the First Circuit has now held in this case that the patent in suit is invalid as to all of its claims because petitioner should have disclaimed claim 7 as well as claim 8, the reason being that claim 7 was not "definitely distinguishable" from claim 8 within the meaning of the statute.

For the sake of the convenience of the Court we reproduce below, in side-by-side comparison, the two claims now in issue.

"8. In a machine for producing duplicate copies of matter printed in reverse on a master sheet,	"7. In a machine for producing duplicate copies of matter imprinted in reverse on a master sheet with copying ink,
a frame,	a stationary frame,

a printing platen revolvably mounted in said frame,	a printing platen rotatably mounted in said stationary frame,
means for securing said master sheet to said printing platen,	
means for intermittently rotating said printing platen,	an intermittent gear adjustably secured to said printing platen to intermittently rotate it,
a pair of feed rolls for feeding a clear sheet of paper,	combined feeding and moistening rolls mounted in said stationary frame,
means for applying a limited film of volatile moistening fluid to the face of one of said feed rolls to be deposited on a clear sheet of paper as it passes between said pair of feed rolls,	means to convey moistening fluid to one of the said rolls,
means for revolving said feed rolls in unison with the rotative movement of the printing platen and a pressure roll for pressing the clear sheet against the master copy."	means for rotating said feeding and moistening rolls in unison with said printing platen to feed a clear sheet to contact with a master sheet secured to said printing platen and means to press said clear sheet against the master sheet."

Argument.

This case does not present any conflict whatsoever with previously decided cases. The decisions of the District Court and the Court of Appeals in this case are in complete accord and harmony with each other and with the six reported cases on this subject matter. There is no "important question of federal law" which is here presented for the Court's decision; every point raised by petitioner has been adequately covered in previous decisions.

No difficulty has been experienced by the public in understanding or interpreting the statutes involved; and the recorded decisions are ample to give any unbiased lawyer a clear understanding of this phase of patent law.

The petitioner, in its zeal for another hearing, has repeated at length its arguments on the merits unsuccessfully made before the appellate court. But certiorari jurisdiction is not exercised by this Court to give a defeated party another hearing.

1. A Difference in Scope is Not Per Se Sufficient to Render Claims Definitely Distinguishable.

Petitioner states that "the primary question is whether two claims, one of which is narrower than the other, i.e., of different scope, are on that account 'definitely distinguishable' from each other." There are only six reported cases which deal with the issue of whether two claims are "definitely distinguishable." They are—

Maytag Co. v. *Hurley Machine Co.*, 307 U.S. 243.
Bulldog Electric Products v. *Cole Electric Products Co.*, 148 F. (2d) 792.
Apex Electrical Co. v. *Maytag Co.*, 122 F. (2d) 182.
Duraloy Co. v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291.

Wiegand v. *H. E. Trent Co.*, 122 F. (2d) 923.
E. L. Bruce Co. v. *Bradley Lumber Co.*, 79 F. Supp. 176.

The first five of these six cases happened to involve situations in which the claims compared were held *not* to be definitely distinguishable. The Bruce case involved a ruling that two claims *were* "definitely distinguishable," for what we believe to be entirely adequate reasons. In every one of the first five cases the two claims compared were different in scope. For example, in the Maytag case, which involved a washing machine, disclaimed claim 38 merely required that the opposed currents of fluid "flow inwardly," whereas claim 39 added the further limitation that the currents meet and flow not only inwardly but also vertically toward the source of agitation. Obviously, it would be possible to construct a washing machine in which the currents met and flowed inwardly without flowing vertically. Moreover, in claim 38 there was the requirement that the clothes be *suspended,* but in claim 39 there was the different requirement that the fabrics *"be freely moved about."* Thus the two claims differed in scope. The real sense of Mr. Justice Roberts' opinion was that the claims were obviously directed to the same concept in spite of the fact that one claim was more explicit than the other on one point.

In the Bulldog case the claims compared were as follows:

"13. A sectional duct run comprising duct sections joined end to end and divided longitudinally into cooperating members, one of

"14. A sectional duct run comprising duct sections joined end to end and divided longitudinally to provide similar and comple-

which overlaps the other at one end and underlaps the other at the other end, a group of bus runs in the duct run symmetrically and similarly disposed with respect to the opposed surfaces of the members, plug entrances on opposite sides of the duct, the entrances on one side being longitudinally offset from the entrances on the opposite side so that a bus run part exposed to one entrance is not exposed to the opposite side entrance."

mentary duct halves provided with external flange means for joining the halves longitudinally and for providing anchorages for the duct run, the duct halves being so arranged that one overlaps the other at one end and underlaps the other at the other end, the flanges providing means for joining neighboring duct sections in end to end relation, a group of bus runs in the duct run symmetrically and similarly disposed with respect to the meeting and joining lines of the duct halves."

In the first place it will be observed that the claims in the Bulldog case were directed to structure, whereas the claims in the Maytag case were directed to a method; it is therefore established that the doctrine of the Maytag case is applicable to patents on structure, as well as to patents on process. Claim 13 had been disclaimed and the issue in the Bulldog case was whether claim 14 was or was not "definitely distinguishable" from claim 13. It is important to note that claim 14 is *narrower in scope* than claim 13. For example, claim 13 calls for duct sections divided longitudinally "into cooperating members," whereas in claim 14 the members are not only divided longitudinally but are divided to produce "similar and complementary duct halves." Moreover, the duct halves in claim 14 were limited to those provided with external flange means for

joining the halves longitudinally. If it were true that a narrower claim is *ipso facto* "definitely distinguishable" from a broader claim, as appellant would have the Court believe, claim 14 in the Bulldog case would have to have been held "definitely distinguishable" from claim 13.

But the Court held as follows:

> "Despite the differences in the language, what each of the claims covers when read on the specifications in the patent is not definitely distinguishable from the coverage of the other. We think it obvious that they cover the same construction though the claims show minor differences in details which neither add to nor detract from what is claimed as the patentee's invention."

The Apex case also expresses the same refusal of a court to hold claims definitely distinguishable although obvious differences in scope existed between them. We reproduce here the claims considered in the Apex case.

"3. The combination with a base, of a support adjustably arranged on the base, a driven shaft on the support, a retaining device acting to hold the support in adjusted position on the base, and means cooperating with said retaining device and acting to prevent its disengagement from the base when the driven shaft is running and permit such disengagement when the driven shaft is idle."

"4. The combination with a base, of a support rotatively mounted on the base, a driven shaft on the support, a slidable retaining pin acting to hold the support in adjusted position on the base, and means cooperating with said retaining pin and acting to prevent its disengagement from the base when the driven shaft is running and to permit such disengagement when the driven shaft is idle."

It will be noted that claim 4 is narrower than claim 3, again demonstrating the fact that a difference in scope is not enough *per se* to render two claims definitely distinguishable. Claim 3 recites merely "a retaining device acting to hold the support," while claim 4 specifies "a slidable retaining pin acting to hold the support." A machine could be built which would infringe claim 3 of the Apex case without infringing claim 4 (by the use of a retaining device other than the slidable pin), but the Court held:

> "That claims 2, 4 and 8, here relied on, are not definitely distinguishable from the disclaimed claims 1, 3, 5, and 11 we think there can be no doubt."

Another case of importance is *Duraloy Co.* v. *Carnegie Illinois Steel Corp.*, 43 F. Supp. 291. The gist of the Duraloy case was that, when two claims differed only in that an element in only one of them was required to be "adjustable," the claims were not "definitely distinguishable" within the meaning of the Maytag doctrine. Judge McVicar pointed out that the specification of the patent involved in the Duraloy case made no particular point of the adjustability of the element concerned. The implication is that the claims were held not definitely distinguishable because one did not express a concept of invention any different from that expressed in the other.

In the Wiegand case the Court of Appeals for the Third Circuit upheld Judge Kirkpatrick's decision that in three separate patents there were sets of claims not distinguishable from others which had been disclaimed in those patents. In this connection Judge Kirkpatrick's language is extremely cogent. He held, in respect to the first patent, the only difference between two claims to be that in one of them the material was "artificially compacted," whereas the other claim called for compacting the material by "sub-

jecting the element to pressure." He made the following statements:

> "It is no answer to say that a device could be found or has been found which would infringe claim 1 but not infringe claim 2. The real point is that whatever distinction may exist between the two claims is upon a point which has not the slightest real bearing upon the essence of the patent."

The last sentence should be written in letters of brass because it expresses with exceptional clarity the very heart of the law which should be applied to this case.

Again, in the third patent considered by Judge Kirkpatrick the only substantial difference between the disclaimed claim and the other claim not disclaimed was that the disclaimed claim recited a heating element generally, while the other claim required that the heating element be in the form of a strip. The judge stated:

> "A strip heater is merely one form adapted to the convenience of users for certain purposes. No one contends that the form—strip, disc, or ring—has anything to do with the invention claimed."

It should be noted that, in all three of the patents involved in the Wiegand case, the *disclaimed claim was broader than the claim not disclaimed*—not only that, the trial judge commented on the differences in scope and specifically said that it made no difference for purposes of the Maytag rule that a device could be built which would infringe only one of the two claims compared.

In every one of these cases the claims compared are different in scope, one being broader than the other, and yet in every one of those cases the claims were held not to be definitely distinguishable within the meaning of the statute.

We respectfully submit that it would be a work of supererogation at this late date to re-examine the matter and again declare as law that which the five cases above discussed have already abundantly made clear.

In the Bruce case there was involved a patent relating to a method of finishing wood, particularly flooring, by applying to it certain oils and compounds and then subjecting the wood to heat. Now claim 1 had been disclaimed; it called for the use of "heat which penetrates." Claim 2, which had not been disclaimed, specified "heating by radiation which is predominantly infra-red in wave length." The Court held that these two claims were definitely distinguishable.

> "Any type of heat will penetrate but only heat by radiation will penetrate the object as a ray and turn into heat within and be absorbed by the object. Radiation heats not from the outside in but from the inside out."

There was a clear difference in *concept*, and we submit that the Court reached the right conclusion. To refer back to Judge Kirkpatrick's decision, it strikes us that the Bruce case is a good example of where the distinction between the two claims is upon a point which *does have* "real bearing upon the essence of the patent." It should also be noticed that the claims in the Bruce case clearly pointed out the significant difference; it was there for anyone to read. It did not require devious sophistical argument to develop it. Another point should be noted: Obviously the claims in the Bruce case would differ in scope, very definitely so; however, the claims were not held to be distinguishable merely because their *scopes* differed, but because the specification of heat by radiation in the infrared wave length region very definitely involved a depart-

ure in *concept,* and in essence, and had a real bearing on the invention.

Reduced to its essentials, petitioner's argument leads to the erroneous conclusion that one claim is definitely distinguishable from another if it be more specific in its terms than the other. Petitioner states at page 12: "Likewise, a more specific definition of one of the elements makes a claim narrower." Petitioner states that claim 8 was too broad, and therefore invalid, but a broad invalid claim is not rendered valid merely because it is rewritten to be more specific. The rewriting must define an invention. In other words, if the concept expressed in a claim is not patentable, it is of no avail to describe that unpatentable concept in more specific terms. The important thing in any claim is that it clearly and distinctly point out *an invention.*

2. Claim 7 Expresses No Concept Not Found in Claim 8.

(*a*) *"Convey" vs. "Apply."*

Disclaimed claim 8 contains the expression: "means for applying a limited film of volatile moistening fluid to the face of one of said feed rolls." Claim 7 reads in part: "means to convey moistening fluid to one of said rolls."

Petitioner argues that "convey" is a more limited term than "apply." However, the opinion of the Court of Appeals disposed of this contention (R. p. 79):

> "Moreover, patents are not to be read with the attention focused solely upon an unabridged dictionary and an English grammar. The purpose of a patent is to disclose the invention described therein to the public, that is, to the part of the public skilled in the art to which the patent appertains, and hence they are to be read as those conversant with the art involved would

read them. And so read the plaintiff's argument falls to the ground."

The specification of the Storck patent does not bear out the special meanings petitioner desires to read into "apply" and "convey." We find in the specification the following words used synonymously: "apply," "deposit," "supply," "feed," "spread," "distribute."

Moreover, the Storck specification reads (R. p. 15, col. 1, lines 22-34):

> "It is to be noted that the wick alone is relied upon to supply moisture to the damping roller in the preferred form of my invention shown in Figs. 1, 2, 3, 5 and 6, and in such form I prefer to use a closely compacted, degreased, wool felt which feeds the liquid slowly and spreads it very evenly upon the face of the damping roller, and wherever in the following claims I use the term 'sole wick means' for supplying moisture, I hereby intend to exclude any means, such as immersion of the damping roller in the liquid as added means, for applying moisture to the damping roller in conjunction with the wick means."

Storck, then, used the word "apply" as descriptive of the wick action. He nowhere stated that the word "convey" was limited to a wick or excluded the wallower roll as "*added* means for *applying* moisture" (italics ours).

(*b*) *The Intermittent Gear.*

Claim 7 calls for "an intermittent gear adjustably secured to said printing platen to intermittently rotate it."

Disclaimed claim 8 reads in part: "means for intermittently rotating said pivoting platen."

In the specification, R. p. 15, col. 2, line 5:

> "The intermittent gears 55 and 56 are of the *usual construction* . . ." (italics ours).

At R. p. 16, col. 1, line 73, he stated:

> "I do not, however, wish to be limited to the form shown, as it is apparent that modifications may be made *in the form* and arrangement of the parts without departing *from the spirit of my invention*" (italics ours).

We submit that to utilize the "usual" intermittent gear (which was old in the art, R. pp. 24, 82) in place of some other means for securing intermittent rotation was not a difference in concept sufficient to render one claim definitely distinguishable from the other.

(c) *Adjustability.*

Petitioner argues that, because the intermittent gear is described in claim 7 as adjustable, the claim therefore is definitely distinguishable from claim 8. The District Court found that this difference "adds nothing of substance to claim 8 for purposes of the Maytag rule." The specification of the patent offers no explanation which would be helpful. Consequently both lower courts followed *Duraloy Co.* v. *Carnegie Illinois Corporation,* 43 F. Supp. 291. The Court of Appeals held: "There is nothing anywhere in the patent to indicate that Storck intended his feeding-moistening-positioning rolls to be anything but adjustable with reference to the platen."

3. The Alleged Conflict.

Petitioner alleges that the decision of the Court of Appeals here is in conflict with *E. L. Bruce Co.* v. *Bradley Lumber Co.*, 79 F. Supp. 176. That case, as we have pointed out above, involved a claim which expressed a concept not suggested at all in the disclaimed claim. Consequently there is no conflict between that case and the case at bar, where claim 7 completely fails to present any important concept or thought not found in disclaimed claim 8.

Conclusion.

This case offers no questions of importance. The law is clear. Petitioner's "points," "questions," and "reasons" offered in support of the petition boil down to a dissatisfaction with the facts found by the lower courts and not with the law applied to them. In other words, petitioner really asks this Court to hold that "conveying" is definitely distinguishable from "applying"; that an "intermediate gear" for rotating a member is definitely distinguishable from "means for intermittently rotating" the same member; and that a member which is adjustable is dramatically different from a member which may or may not be adjustable.

Two courts have considered these same contentions and have been unimpressed; we are confident that this Court will not disturb opinions so clearly in accord with public policy.

Respectfully submitted,

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